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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,960	05/29/2001	Neil D. Scancarella	Rev 01-6	7403

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EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 01/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,960

Applicant(s)

SCANCARELLA ET AL.

Examiner

Clinton Ostrup

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-87 are pending in this application.

Specification

Claims 21 and 22 are objected to because of the following informalities:

- Claim 21 also contains two periods, one of which must be deleted.
- Claim 22 does not currently exist, therefore, this claim must be cancelled.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-17, 21, 23-25, 27-29, 33, 41-44, 50, 58-61, 63-65, 76-78, 80 and 87 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the water phase", however, there is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the oil phase", however, there is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the organic pigments", however there is insufficient antecedent basis for this limitation in the claim. Examiner respectfully suggests applicant be consistent in their terminology and change "the organic pigments" to "the at least one organic pigment."

Claim 6 is rejected for reasons analogous to those of claim 5 above.

Claim 7 recites the limitation "the surface", however there is insufficient antecedent basis for this limitation in the claim.

Claim 8 recites the limitation "the red pigment", however there is insufficient antecedent basis for this limitation in claim 5 from which this claim depends.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 8 recites the broad recitation of the red color is a D&C or FD&C color or Lake thereof, and the claim also recites the color being selected from monoazo, disazo, fluoran, xanthene or indigoid pigment which is the narrower statement of the range/limitation.

Claim 10 recites the limitation "the green pigment", however there is insufficient antecedent basis for this limitation in claim 5 from which claim 10 depends.

Claim 12 recites the limitation "the blue pigment", however there is insufficient antecedent basis for this limitation in claim 5 from which claim 12 depends.

Claim 12 is vague and indefinite because it recites a broad limitation wherein the color is a D&C or FD&C color or Lake thereof, and the claim also recites the color and being a triphenylmethane pigment which is the narrower statement of the limitation.

Claim 13 recites the limitation "the yellow pigment", however there is insufficient antecedent basis for this limitation in claim 5 from which claim 13 depends.

Claim 13 is vague and indefinite because it recites a broad limitation wherein the color is a D&C or FD&C color or Lake thereof, and the claim also recites the color and being selected from pyrazole, monoazo, fluoran, xanthene, or quinoline which is the narrower statement of the limitation.

Claim 15 recites the limitation "the oil phase", however, there is insufficient antecedent basis for this limitation in claim 1 from which claim 15 depends.

Claims 21, 41, 58, and 76 are vague and indefinite because it is unclear what constitutes an "eyelash color", "brow color", or "lip color". These terms are not defined in the specification and one skilled in the art would not reasonably be apprised of the scope of the claims.

Claim 23, 42, 59, and 77 recite the limitation "the desired surface", however, there is insufficient antecedent basis for this limitation in claim 1 from which claim 23 depends.

Claims 27-29, 46-47, 63-65, and 80 recite the limitation "the viscosity modifying agent" however there is insufficient antecedent basis for this limitation in the claims.

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Furthermore, the metes and bounds of what constitutes "the viscosity modifying agent" is unclear.

Claims 33 and 50 recite the limitation of a "hydrophobic agent", however, hydrophobicity is a relative term and therefore the metes and bounds of what constitutes a hydrophobic agent as claimed are unclear.

Claim 87 recites the limitation of the composition not containing any "organic gelling agents", however, an organic gelling agent is not clearly defined by the claims or the specification therefore, one skilled in the art would not be appraised of the scope of the claims without knowing the metes and bounds of what constitutes an "organic gelling agent".

Any remaining claims are rejected as depending on indefinite base claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, 76, 79-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott, **US 6,248,336 B1** (McDermott).

McDermott teaches cosmetic make-up compositions suitable for mascaras in the form of aqueous emulsions. The emulsions are taught to comprising insoluble polymeric material in an aqueous emulsion or latex and a lipophilic oil. These emulsions are then used to produce mascaras with improved wear and water resistance and are removable with soap and water. See: col. 1, lines 4-68 and abstract.

McDermott describes how polymeric emulsions containing plasticizers and solvents are well known in the art and that these compositions contain thickeners including water-soluble and water-swellaable polymers typically used in the art. See: col. 1, lines 26-40.

The primary reference describes how the compositions of their invention can be fabricated into a multitude of forms such as water-in-oil and oil-in water-emulsions to make creams and pastes. Thus meeting the limitations of instant claims 1-2, 30, 48, 66, 81, and 86. The primary reference teaches that the proportion of pigments used depends on the color and intensity of the color desired and that the pigments are selected from inorganic pigments, organic lake pigments, pearlescent pigments, and mixtures thereof. McDermott describes how the pigments may be surface-treated and teaches the specific inorganic and organic pigments of instant claims 5-8, 13, 31-33, 49-50, 67-68, and 82-83. See: col. 6, lines 1-45.

The primary reference teaches that optional ingredients such as silica, mica, talc, polymethacrylate, polyethylene, and thickeners such as water dispersible clays, which meet the specific limitations of instant claims 26-29, 45-47, 62-65, and 79-80. See: col. 6, line 45 – col. 7, line 10. McDermott exemplifies as an object of the invention to provide a mascara composition which comprises an alkyl or alkoxy-dimethicone copolyol as well as the insoluble polymeric material in an aqueous medium. See: col. 2, line 1 – col. 5, line 4.

McDermott teaches the use of polar oils and volatile oils, which meet the volatile components of instant claims 15-17, 36-37, 53-54, 71-72, and 84-85. However, McDermott lacks the teaching of the phases in which the emulsions contain the pigments and the pigment colors of instant claims 9-12, 14, 30, 48, 66, and 81.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the organic and inorganic pigments by surface-treating them to make them soluble in either a hydrophobic or a hydrophilic environment because of the reasonable expectation that the surface coating of said pigments would produce pigments which could be solubilized in the desired environment. Furthermore, McDermott teaches that the compositions of their invention are preferably in water-in-oil and oil-in water emulsions and that it is within the scope of their invention to surface treat pigments with a variety of compounds. It would have also been obvious to a skilled artisan to substitute one pigment color for another because of the expectation of successfully obtaining an emulsion composition with a desired color.

Claims 1-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott, **US 6,248,336 B1** (McDermott) as applied to claims 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, 76, 79-85 above, and further in view of Alwattari et al, **5,985,258** (Alwattari) and Krzysik, **5,512,272** (Krzysik).

McDermott discloses water-in-oil and oil-in water mascara compositions as described above, however, the primary reference lacks the silicone film forming polymer the pigment colors, and the plasticizer of instant claims 9-12, 14, 18-20, 23-25, 30, 34, 38-40, 42-44, 48, 51, 55-57, 59-61, 66, 69, 73-75, 77-78, 81, 86, and the absence of non-polymeric, organic gelling agents of instant claim 87.

Alwattari teaches mascara compositions comprising water insoluble polymeric materials and water-soluble, film-forming agents. See: col.1, lines 10-15; col.2, line 9 – col. 4, line 19; and abstract. The secondary reference teaches alkyl-methicones as waxes, which can be used in their invention and teaches many of the organic and inorganic pigments as claimed instantly. See: col. 5, line 20 – col. 6, line 63. The secondary reference describes how polymeric emulsions typically include water soluble polymers and that the polymeric materials of their invention contain acrylate copolymers with added ammonia, propylene glycol, preservatives, and surfactants, thus meeting the plasticizer limitation of instant claims 23-25, 42-44, 59-61, and 77-78. See: col. 2, line 60 – col. 3, line 15.

Krzysik teaches cosmetics with enhanced durability wherein the improvement to the composition is the aqueous latex of a crosslinked polyorganosiloxane. See: col. 1, line 9 – col. 2, line 9 and abstract. The reference teaches an oil-in-water mascara

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composition comprising a film forming agent, a pigment, a wax, an oil, and a preservative. The tertiary reference teaches silicone acrylates which meet the limitation of instant claims 18-20, 38-40, 55-57, and 73-75 in Table II. See: col. 2, line 14 – col. 5, line 64.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the mascara formulation of McDermott by adding the plasticizers and water-soluble and water-insoluble polymers as taught by Alwattari and the silicone acrylates as taught by Krzysik because of the reasonable expectation of obtaining a mascara composition with enhanced durability, capable of comprising film forming polymers in both the water phase and the oil phase.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on M-F (8:30am-5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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Clinton Ostrup
Examiner
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January 25, 2002

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